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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,183	02/14/2002	Yoshiaki Wani	09792909-5341	7271
26263	7590	06/21/2004		
SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080			EXAMINER CANTELMO, GREGG	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,183	WANI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregg Cantelmo	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/12/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to the amendment received April 12, 2004:
  - a. Original claims 1-6 and new claims 7-20 are pending;
  - b. The drawing objection has been overcome in light of the amendment;
  - c. The specification objection has been overcome in light of the newly filed abstract;
  - d. The claim objections have been overcome in light of the amendment;
  - e. The prior art rejections of record have been overcome in light of the amendment.

### ***Information Disclosure Statement***

2. The information disclosure statement filed April 12, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but only select information referred to therein has been considered. Please review the form for those references which have and have not been considered.

JP 06-199491-A is drawn to an outrigger device in a vehicle and has no relevance to the claimed invention.

JP 62-105134-A is drawn to a silver halide photographic sensitive material and has no relevance to the claimed invention.

JP 03-015772-A is drawn to a method and device for searching accident point of indoor winding and has no relevance to the claimed invention.

### ***Drawings***

3. The proposed drawing change filed April 12, 2004 has been approved.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 13 recites the limitation "said body portion" in line 2. There is insufficient antecedent basis for this limitation in the claim. There is no body portion clearly defined in claim 13 or any of the claims upon which claim 13 is dependent upon.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 8, 10, 11, 12, 14, 16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent No. 4,210,253 (Rosler).

The instant claims do not provide sufficient structure to limit the function of the case for only holding batteries. The claims have been given their broadest reasonable interpretation to be any casing having the same structure recited in the instant claims. For example, the applied art here are drawn to cosmetic cases. However in terms of the claimed structure, the combination is held to render the instant claims case structure obvious. See MPEP § 2114 and § 2111.02, incorporated herein.

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

Rosler discloses a case including a main body 1 having a first opening portion at one end and a bottom surface 1' at the other end, and a lid portion 2 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural

projection trains 3 run along the length of the main body to the bottom of the body (first and second trains) a third projection train 4 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 8).

The body and lid have a circular cross section (Fig. 2) which is inherently made up of plural circular arc segments (as applied to claims 10 and 11).

The bottom surface 1' is expanded toward the outside via a circumferential ring (Figs. 1 and 2 as applied to claim 12).

Projection portion of trains 3 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 14).

The case comprises a first projection train 3 on the body 1 near the bottom surface of the body and a second projection train 4 formed on the lid 2 near the open end of the lid, wherein the second projection train is adapted to engage the first projection train (Fig. 1 as applied to claim 16).

The body and lid have a circular cross section (Fig. 2) which is inherently made up of plural circular arc segments (as applied to claims 18 and 19).

Plural projection trains are formed on the main body along the span of the body and thus there is a multiple projection trains formed on the main body near the bottom surface and the second projection train (on the lid) is adapted to engage the projection trains (first or third trains) on the main body (Fig. 1 as applied to claim 20).

9. Claims 8, 10, 11, 14, 16 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/24008 (WO '008).

The instant claims do not provide sufficient structure to limit the function of the case for only holding batteries. The claims have been given their broadest reasonable interpretation to be any casing having the same structure recited in the instant claims. For example, the applied art here are drawn to cosmetic cases. However in terms of the claimed structure, the combination is held to render the instant claims case structure obvious. See MPEP § 2114 and § 2111.02, incorporated herein.

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

WO '008 discloses a case including a main body 2 having a first opening portion at one and a bottom surface 7 at the other end, and a lid portion 1 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 11 run along the length of the main body to the bottom of the body (first

and second trains) a third projection train 6 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 8).

The body and lid have a circular cross section (Fig. 1 and abstract) which is inherently made up of plural circular arc segments (as applied to claims 10 and 11).

Projection portion of trains 11 at the bottom of the body 2 are "substantially the same diameter" as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 14).

The case comprises a first projection train 11 on the body 2 near the bottom surface of the body and a second projection train 6 formed on the lid 1 near the open end of the lid, wherein the second projection train is adapted to engage the first projection train (Fig. 1 as applied to claim 16).

The body and lid have a circular cross section (Fig. 1 and abstract) which is inherently made up of plural circular arc segments (as applied to claims 18 and 19).

Plural projection trains are formed on the main body along the span of the body and thus there is a multiple projection trains formed on the main body near the bottom surface and the second projection train (on the lid) is adapted to engage the projection trains (first or third trains) on the main body (Fig. 1 as applied to claim 20).



10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 9, 13, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of U.S. Design Patent No. D 433,562 (Redlinger).

The teachings of claims 8, 10-11, 12, 14, 16 and 18-20 have been discussed above and are incorporated herein.

The differences between claims 9, 13, 15 and 17 and Rosler are that Rosler does not teach of providing a through-hole in the head portion of the lid (claims 9 and 17), of the head portion having a space portion between the hole and body (claim 13), wherein the through hole has a concave portion and a cylindrical portion (claim 15).

Rosler is broadly drawn to a container which can be used as a container for any number of items.

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 13 and 15 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by configuring the lid to have the through hole placed and configured as defined in claims 13 and 15 since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosler in view of U.S. Design Patent No. D 433,562 (Redlinger).

The instant claims do not provide sufficient structure to limit the function of the case for only holding batteries. The claims have been given their broadest reasonable interpretation to be any casing having the same structure recited in the instant claims. For example, the applied art here are drawn to cosmetic cases. However in terms of the claimed structure, the combination is held to render the instant claims case structure obvious. See MPEP § 2114 and § 2111.02, incorporated herein.

The claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere

statements of purpose or use “can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim.” *Corning Glass Works*, 868 F.2d at 1257, 9 USPQ2d at 1966. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction.

Rosler discloses a case including a main body 1 having a first opening portion at one end and a bottom surface 1' at the other end, and a lid portion 2 having a second opening at one end of the lid portion and a head portion at the opposing end, a plural projection trains 3 run along the length of the main body to the bottom of the body (first and second trains) a third projection train 4 is formed on the lid and is adapted to engage any of the projection trains on the main body (Fig. 1 as applied to claim 1).

The body and lid have a circular cross section (Fig. 2) which is inherently made up of plural circular arc segments (as applied to claims 2 and 3).

The bottom surface 1' is expanded toward the outside via a circumferential ring (Figs. 1 and 2 as applied to claim 5).

Projection portion of trains 3 at the bottom of the body 2 are “substantially the same diameter” as the opening of the lid. The term substantially renders a degree of latitude to the diameters being exactly the same and thus can be slightly larger or

smaller so long as they are about the same diameter and permit the same insertion of the body into the lid (as applied to claim 6).

The differences between claims 1, 4 and 7 and Rosler are that Rosler does not teach of providing a through-hole in the head portion of the lid (claim 1), of the head portion having a space portion between the hole and body (claim 4), wherein the through hole has a concave portion and a cylindrical portion (claim 7).

Rosler is broadly drawn to a container which can be used as a container for any number of items.

Redlinger shows a lid having a through hole in the head portion of the lid wherein the hole is disposed in a central area of the lid and has a concave portion and cylindrical portion (Figs. 1-4).

The motivation for providing a through hole in the head portion of the lid is that provides a an attachment point on the container and permits attaching the container to other means.

The motivation for configuring the lid to have the through hole placed and configured as defined in claims 4 and 7 permits attachment of the container to a key ring whereat additional elements can also be attached to the ring.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by providing a through hole in the head portion of the lid since it would have provided a an attachment point on the container and permitted attaching the container to other means.

It would have further been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of Rosler by configuring the lid to have the through hole placed and configured as defined in claims 13 and 15 since it would have permitted attachment of the container to a key ring whereat additional elements could also be attached to the ring.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. patent Nos. 5,605,242 (Hwang), 1,450,674 (Martson), and 1,189,052 (Brookshire) all disclose of providing projection trains along the body and lid of containers and cylindrical elements.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is (571) 272-1283. The examiner can normally be reached on Monday to Thursday from 9 a.m. to 6 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. FAXES received after 4 p.m. will not be processed until the following business day. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregg Cantelmo  
Primary Examiner  
Art Unit 1745

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*Garry Cant*

June 17, 2004

